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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/501,217 02/10/00 MURAD

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HM12/1105

EXAMINER

CHANNAVAJJALA, L

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/501,217

Applicant(s)

MURAD, HOWARD

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt of amendment A, dated 8-20-01 is acknowledged.

The following rejection has been maintained for reasons of record:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/501,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims directed to a method of managing one or more dermatological conditions utilizes the same a composition that reads on the instant claimed composition. Accordingly, the instant composition is over the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 102

Claims 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by USPN 5,985,300 to Crotty et al (Crotty).

Crotty discloses skin care compositions containing fruit extracts, zinc salts and other components such as ceramides, vitamins, mono- or polyhydroxy acids etc. See abstract, col. 4, lines 15-22 and col. 5, lines 12-40. Absent showing evidence on the contrary, the fruit extracts of Crotty have the capability to neutralize free radicals, as claimed. Accordingly, Crotty anticipates the instant claims 24-27.

The following is a new rejection:

Claim Rejections - 35 USC § 102

Claims 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by USPN 5,571,503 to Mausner.

Mausner discloses anti-pollution cosmetic composition, which incorporates a combination of ingredients for skin protection from environmental pollution, while providing significant protection against moisture loss and damage due to free radical activity and UV light. The composition comprises an anti-pollution complex comprising wheat protein, mannitol, glycerol etc., micellar complex comprising phospholipids & hyaluronate; and anti-free radical complex comprising tocopherol, ascorbic acid etc., (col. 1, lines 35-68). Further, Mausner teaches addition of ancillary (preferable) ingredients such as a hydrophilic component and a

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lipid-soluble component, which include the claimed dimethicone, glycerin etc. (col. 2-3).

Mausner suggests that the micellar complex components provide hydration and moisturizing activities to the skin (col. 9, lines 14-45). Although Mausner does not specifically teach a combination of moisturizing agents as in the instant claim, glycosphingolipids read on the instant hydrophobic moisturizing component; hydrolyzed wheat protein & hyaluronate read on hydrophilic component. Further, Mausner does not teach ascorbic acid as a moisturizing agent. However, the composition of Mausner requires ascorbic acid along with other components and the moisturizing activity is implicit to ascorbic acid. Mausner also discloses a fruit extract such as apricot kernel in their composition.

Claim Rejections - 35 USC § 103

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,571,503 to Mausner in view of 5,985,300 to Crotty et al and 5,891,440 to Lansky.

The teachings of Mausner have been discussed above. However, Mausner lacks the instant pomegranate extract in their composition.

Crotty discloses skin treatment compositions (i.e., dermatological agent) containing fruit extracts, plant extracts, phytoestrogens, herbal extracts, alpha- and beta-hydroxycarboxylic acids, anti-inflammatory, vitamins, flavonoids etc., all of which read on the claimed moisturizers, sunscreens, transition metals, anti-inflammatory agents, immunity boosting agents, ceramides, zinc salts etc. See col. 2, lines 40 through col. 5, lines 43, for individual vitamins, hydroxycarboxylic acids, plant or herbal extracts and other components. Crotty suggests adding phytoestrogens in their skin care compositions because of their antioxidant or free radical inhibiting activity. See table in col. 3. Thus, Crotty and Mausner teach a combination of several

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ingredients that include moisturizers, antioxidants, anti-inflammatories etc. Therefore, it would have been obvious for a skilled artisan at the time of the instant invention to incorporate phytoestrogens of Crotty in the anti-free radical complex of Mausner, with an expectation to provide anti-free radical activity to reduce/inhibit the free radical activity due to environmental exposure. However, Crotty fails to teach pomegranate extract in their composition.

Lansky described above, teaches pomegranate extracts in topical composition for supplementing phytoestrogens. Lansky teaches extracting pomegranate seeds and admixing with other herbal extracts such as licorice (col. 4) and using as a skin cream (abstract, col. 2, lines 3-36) Further, Lansky recognizes that pomegranate seed extracts have been used for treating oily skin (col. 2, lines 20-23). Lansky teaches topical as well as oral administration of phytoestrogens.

Accordingly, it would have been obvious for one of an ordinary skill in the art to add phytoestrogen containing pomegranate extracts of Lansky in the place of phytoestrogens (of Crotty) in the skin care compositions of Mausner, with an expectation to improve the condition of skin, because Lansky discloses that pomegranate extracts (containing phytoestrogens) are known for treating oily skin conditions and Crotty teaches plant extracts, phytoestrogen extracts, flavonoids extracts as free radical inhibitors and antioxidants.

Response to Arguments

Applicant's arguments filed 8-20-01 have been fully considered but they are not persuasive.

Double patenting Rejection:

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Applicants stated that this rejection will be addressed when either the copending or the present application is allowed. Accordingly, the rejection is maintained.

Crotty (102 Rejection):

Applicants argue that there is no disclosure or suggestion in the teachings of Crotty for the instant dermatological agent comprising at least one fruit extract in an amount to sufficient free radicals, a transitional metal component in an amount to reduce inflammation and a combination of a hydrophobic, hydrophilic and mono- or poly-hydroxy moisturizing agent. However, the instant hydrophilic moisturizer, hydrophobic moisturizer are very broad and does not specify one compound or a category of compounds. Besides, Crotty teaches herbal extracts such as wheat extract, which are particularly effective for oil control (col. 4, lines 15-22). The same is also listed as one of the hydrophilic moisturizing agents by the applicants (page 15 of the specification). Thus, Crotty discloses all the elements of the instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala (lakshmi.channavajjala@uspto.gov) whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM - 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7921/7924 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Lakshmi Channavajjala
November 1, 2001


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600